



REMARKS

Reconsideration and allowance are respectfully requested. Claims 1-15 remain pending.

The Examiner objected to the drawings. A Replacement Sheet of FIGS. 1-3 is attached, labeling each of these Figures as "Prior Art".

Claims 1-15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over McMillen (US 4296343) in view of Yamaguchi et al. This rejection is respectfully traversed.

The Examiner concedes that McMillen does not teach the "generally S-shaped structure defining an entirely curved and non-planar transition". The Examiner cites Yamaguchi as teaching a raised portion (d) joined directly with a surface defining a recess by a "generally S-structure thereby defining an entirely curved and non-planar transition there-between". The Examiner contends that it would have been obvious "to modify the S-shaped structure of McMillen in view the S-shaped structure as taught by Yamaguchi because it provides a means for holding magnets in a case without requiring any binding agent, springs or screws".

First, the "S-shaped" structure of McMillen requires the planar portions (see Applicants' previous Response FIG. 3, Item A of McMillen) since they are part of the flat sidewalls 46 and 48, from which raised portions 54 and 56 are formed. See also FIG. 8b of McMillen wherein planar portions join items 85 and 80. McMillen teaches at column 3, lines 28-31 "a pair of generally parallel flat sidewalls 46 and 48, preferably fabricated by flattening sidewalls of a section of tubing, such as round tubing. The housing 12 could also be constructed from a flat sheet of ferrous material." One of ordinary skill in the art would not purposely form housing walls to be flat (sidewall 46 and 48) and then modify these walls to be continuously curved and non-planar as suggested by the Examiner. Furthermore, the "S-shaped structure" of Yamaguchi also has a planar portion as indicated by the horizontally extending thick line near item C in FIG. 3 of Yamaguchi and is thus not entirely curved and non-planar as required by the claims.

Secondly, one of ordinary skill in the art would not modify McMillen in view the "S-shaped structure" as taught by Yamaguchi "because it provides a means for holding magnets in a case without requiring any binding agent, springs or screws", as the Examiner contends. There is simply no suggestion that the magnets 50 and 52 of McMillen are insufficiently held. In fact, the "S-shaped structure" of McMillen is not even near the magnets 50, 52 and does not in any way hold the magnets. Finally, since the S-shaped structure of Yamaguchi is not part of the outer periphery of the case 1a (as in McMillen) but is an internal member, it is not evident how such a feature can be incorporated into the sidewalls 48 and 46 by using shaped dies and mandrel as taught by McMillen.

"Teachings of references can be combined only if there is some suggestion or incentive to do so." *In re Fine*, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (*quoting ACS Hosp. Sys. v. Montefiore Hosp.*, 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original). It is well settled that a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but some motivation to combine the prior art teachings in the particular manner claimed. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." (emphasis added)); *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." (emphasis added)).

There is simply no suggestion or motivation to modify McMillen in the manner suggested by the Examiner. Therefore, the rejection of claims 1, 6 and 10 and the claims that depend there-from is improper and should be withdrawn.